REMARKS

Claims 1-17 are now pending in this application. Claims 1, 4, and 8-10 are in independent form.

Claims 1, 4, and 8-10 have been amended. No claims have been canceled or added.

Objection to the Abstract

The Office Action maintains an objection to the Abstract because of the phrase "is provided" in the first sentence. The abstract has been amended to exclude the objected-to phrase. Applicant respectfully submits that the Abstract is in condition to overcome the objection.

Claim Rejections Under 35 U.S.C. § 103 (Yoneyama+Moody+Andros+Chung)

The Office Action rejects claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0064707 issued to Yoneyama (hereinafter "Yoneyama") and in further view of U.S. Patent Publication No. 2003/0167310 issued to Moody et al. (hereinafter "Moody"), U.S. Patent No. 4,817,194 issued to Andros, Jr. (hereinafter "Andros"), and U.S. Patent Publication 2002/0063738 issued to Chung (hereinafter "Chung"). These rejections are respectfully traversed.

Yoneyama does not disclose searching for an e-mail already stored in the device's mail storage.

Independent claims 1 and 4 recite, in part, "a mail search portion searching on the basis of the e-mail (displayed on the mail viewing screen/designated by the user) for an e-mail among the plurality of e-mails stored in said mail storage ". That is, the mail search portion searches for an e-mail *already stored* in the mail storage of the portable device. In contrast, Yoneyama uses a key word to search past e-mails, which are not disclosed to be stored on the device, and *then* retrieves the searched for e-mail. (See Figure 3, and paragraph [0013]). The Office Action acknowledges that a retrieved e-mail may be, in the Yoneyama device, stored temporarily for purpose of display. (OA, page 3). However, Yoneyama does not disclose that the retrieved e-

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mail is searched while temporarily stored on the device. In the temporary storage situation, the retrieved e-mail would be stored on the device only as *result* of a search performed previous to retrieval. Thus, Yoneyama does not disclose "searching for an e-mail among the plurality of e-mails stored in said mail storage".

Yoneyama does not disclose mail storage storing a plurality of e-mails..

Independent claims 1 and 4 further recite, in part, "[a] portable e-mail viewing device comprising: a mail storage concurrently storing a plurality of e-mails". The Office Action asserts that "in order for Yoneyama's invention to retrieve and then display e-mail messages it must inherently be storing the mail messages (whether temporary or not), and Yoneyama further provides that these e-mail messages are stored somewhere on the device." Applicant respectfully disagrees with this line of reasoning. Yoneyama does not disclose a device that includes "mail storage concurrently storing a plurality of e-mails". If the "storage" of an e-mail by the Yoneyama device is temporary for purposes of display, it does not inherently follow that a plurality of searched-for past sent/received messages is concurrently stored on the device, nor that a displayed message is concurrently stored in a mail storage with a searched-for mail. Yoneyama does not disclose simultaneous display of plural e-mail messages; therefore, simultaneous storage of a plurality of e-mail messages is not inherent. "Retrieval" of a searched message does not require transfer to and storage in a mail storage portion of a device, but merely indicates that the searched message has been identified for use.

Yoneyama does not disclose arrangement "based on a transmission time of sent e-mail or a reception time of received e-mail."

Claims 1 and 4 variously further recite that "when said operation unit accepts the mail switching operation first input after said e-mail is displayed on said mail viewing screen, said mail search portion searches said plurality of e-mails, and generates index data for arranging in time sequence each of said plurality of e-mails based on a transmission time of sent e-mail or a reception time of received e-mail". The Office Action asserts that Figure 6j of Yoneyama "depicts the retrieved e-mails are sorted by date/time." (OA, page 4). However, sorting "by

date/time" is not the same as "arranging in time sequence ... based on a transmission time of sent e-mail or a reception time of received e-mail". Yoneyama does not disclose whether the e-mail headers of *received* messages are sorted by date transmitted by the sender (transmission date) or by date received by the receiver (receipt date). It is not obvious that one or the other should be used, since either date may be of utility. Moreover, based on the usage in Yoneyama paragraphs [0046] and [0048], the "sent date" and "received date" referred to in Yoneyama paragraphs [0055]-[0057] may be interpreted to merely indicate dates that correspond in an undisclosed manner to past "sent" and "received" e-mails, and therefore do not refer to transmission/receipt dates, much less transmission/receipt <u>times</u>.

Yoneyama and Moody do not together disclose that a mail search portion searches a <u>plurality</u> of e-mails, and <u>generates index data</u> for arranging e-mails in <u>time</u> sequence.

Yoneyama does not disclose that the e-mail headers are arranged in <u>time</u> sequence by time received/transmitted; Figure 6j depicts only dates; it should not be assumed without support that messages sent/received on the same date are arranged in <u>time</u> sequence. Applicant therefore respectfully asserts that Yoneyama does not disclose a mail search portion that "generates index data for arranging in time sequence each of said plurality of e-mails based on a transmission time of sent e-mail or a reception time of received e-mail," as variously recited by claims 1 and 4.

Moreover, the Office Action concedes that Yoneyama does not disclose a mail search portion that "generates index data for arranging ... e-mails," as recited in claims 1 and 4. The Office Action thus relies on Moody to support of this feature. However, Moody discloses that "preprocessing module 265 determines the <u>date</u> associated with the electronic mail message *m*," then "examines the text body of electronic mail message *m* searching for any of a plurality of recognized date formats." Moody does not indicate whether the "date associated with the electronic message" is a transmission date, a reception date, or whether it includes any *time* information. Although Moody provides an example of a date format that includes time information, that format is only disclosed to be associated with date/time information extracted <u>from the text body of the e-mail</u>, and thus not useful as an index for arranging sent/received e-mails based on transmission/reception times.

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Furthermore, determining a date associated with an e-mail message is not the same as "generat[ing] index data for arranging ... e-mails based on a transmission time of sent e-mail or a reception time of received e-mail." Mere determination of a date associated with one particular e-mail does not render the date useful for indexing. Moody does not use extracted dates to index e-mails. Thus, Applicant asserts, Moody, even in combination with Yoneyama, does not accomplish generation of index data for a "plurality of e-mails", nor arrangement based on transmission/reception times.

Claim Rejections Under 35 U.S.C. § 103 (Yoneyama+Lee+Roth+Douglas)

Claims 8-17 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoneyama in view of U.S. Patent Publication No. 2002/0032743 issued to Lee et al (hereinafter "Lee"), U.S. Patent Publication No. 2004/0049388 issued to Roth et al. (hereinafter "Roth"), and U.S. Patent No. 5,491,784 issued to Douglas et al. (hereinafter "Douglas"). These rejections are respectfully traversed.

Similar to claim 1, independent claims 8-10 each recite in part:

A portable mail editing device comprising:
    a mail storage concurrently storing (data comprising each of) a plurality of reference mails (e-mails); [and]
    a mail search portion searching ... for a reference mail (e-mail) among the plurality of reference mails (e-mails) stored in said mail storage ...;

As discussed above, Yoneyama does not disclose <u>searching for a reference mail stored in the mail storage</u>. Moreover, also as discussed above, Yoneyama does not disclose a mail storage storing a <u>plurality</u> of e-mails (or reference mails). Lee, Roth, and Douglas do not separately or together remedy the deficiency of Yoneyama regarding these features.

Lee, presented in the Office Action as providing simultaneous display of a reply composition and a reference mail, does not remedy Yoneyama regarding storage of a plurality of reference e-mails because Lee is directed to interfacing with web-based e-mail. Thus, emails are stored and manipulated on a server remote from the disclosed device. Accordingly, Lee in combination with Yoneyama still does not disclose storing a plurality of reference mails in a

mail storage portion of the device. Moreover, since a plurality of e-mails are not stored in a mail storage for the device, the device cannot search for a reference mail amount a plurality of reference mails stored in mail storage of the device. Even if, *arguendo*, a web-based e-mail interface could be interpreted to include storage of reference mails on the device, however temporarily, neither Lee nor Yoneyama discloses searching a for a reference mail stored in the device's mail storage, nor that such search is based on a displayed reference mail (as in claim 8), based on a user-designated reference mail (as in claim 9), or based on data of an e-mail displayed according to a user-entered instruction (as in claim 10).

Roth, presented in the Office Action as providing a cursor displayed in a mail edition screen, also does not disclose mail storage concurrently storing a plurality of reference mails, or a mail searching portion that searches for a reference mail among a plurality of mails stored in said mail storage. The speech recognition device disclosed by Roth does not disclose any interaction with e-mail, much less storage or search of stored e-mail.

Douglas, presented in the Office Action as providing wherein the operation mode is automatically changed to copying when the focus of the cursor is moved to the reference window, similarly fails to disclose mail storage concurrently storing a plurality of reference mails or a mail searching portion that searches for a reference mail among a plurality of reference mails concurrently stored in said mail storage.

As the applied art does not disclose every feature of independent claims 8-10, these claims are believed to be in condition for allowance for at least the reasons presented above. Claims 11-17 depend from claim 10 and are therefore believed to be in condition for allowance for at least the same reasons as their parent claim 10. Withdrawal of the rejection and consideration of claims 8-17 are respectfully requested.

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Conclusion

All matters having been addressed in view of the foregoing, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant's undersigned representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains an issue in which the Examiner feels would be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account No. 02-2448. The Commissioner for Patents is also authorized to credit any overpayments to the above-referenced deposit account.

Dated: April 25, 2008   Respectfully submitted,

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